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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,767	12/16/1999	GERALD WAYNE BOTH	50179-073	8030

20277 7590 01/10/2002  
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WASHINGTON, DC 20005-3096

EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 01/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/464,767

Applicant(s)

BOTH ET AL.

Examiner

Scott Priebe

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 May 2001 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1632

## **DETAILED ACTION**

### ***Continued Prosecution Application***

The request filed on 1/3/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/464,767 is acceptable and a CPA has been established. Claims 18 and 23 have been amended. No arguments traversing the rejections or objections of record were provided. An action on the CPA follows.

In addition to the request and preliminary amendment amending claims 18 and 23, applicant filed duplicates of the Petition for Extension of Time, Submission of Sequence Listing and Preliminary Amendment, and Request for Approval of Drawing Corrections that were filed 5/16/01. These duplicates have been placed in the file, but have not been entered, as the original papers have already been entered..

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Oath/Declaration***

The oath or declaration remains defective for the reasons of record set forth in the Office action of 7/3/01. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Art Unit: 1632

***Drawings***

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 5/16/01 remains disapproved because they introduce new matter into the drawings.

***Specification***

The communication received on 5/16/01 remains not fully responsive to the communication mailed 2/16/01 for the reason(s) set forth on the Notice to Comply With the Sequence Rules attached to the Office action of 7/3/01.

Applicants are required to comply with all of the requirements of 37 CFR 1.821 through 37 CFR 1.825. *Any* response to this Office Action which fails to meet *all* of these requirements will be considered non-responsive. The nature of the sequence disclosed in the instant application has allowed an examination on the merits, the results of which are communicated below.

The amendment filed 5/16/01 remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure, for the reasons of record set forth in the Office action of 7/3/01. Applicant is required to cancel the new matter in the reply to this Office action.

The disclosure remains objected to because of informalities for the reasons of record set forth in the Office action of 7/3/01. Appropriate correction is required.

Art Unit: 1632

***Claim Objections***

Claims 1-24 remain objected to because of informalities as set forth in the Office action of 7/3/01. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

Claims 1-2, 8-11 and 24 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of record set forth in the Office action of 7/3/01, because the specification, while being enabling for isolated DNA sequences comprising a nucleotide sequence identical to all or part of the nucleotide sequence of SEQ ID NO: 1 or of Figure 13 and variants of SEQ ID NO: 1 or of Figure 13 comprising nucleotide differences in the viral protein coding sequences that do not alter the amino acid sequence encoded thereby, does not reasonably provide enablement for any other variants of the sequence set forth in SEQ ID NO: 1 or Figure 13. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 4-7 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of record set forth in the Office action of 7/3/01, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 1632

Claims 3, 12-17, 21 and 22 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of record set forth in the Office action of 7/3/01, because the specification, while being enabling for OAV287 vectors comprising all of the nucleotide sequence of SEQ ID NO: 1 and variants of SEQ ID NO: 1 comprising silent nucleotide differences in the viral protein coding sequences of SEQ ID NO: 1 that do not alter the amino acid sequence encoded thereby and methods of using such vectors for transferring heterologous DNA to cultured mammalian cells, does not reasonably provide enablement for any other variants of the sequence set forth in SEQ ID NO: 1, especially with respect to parts of the complete genome less than the whole and methods of transferring heterologous DNA to non-mammalian cells or to cells *in vivo*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claims 18-20 and 23 remain rejected under 35 U.S.C. 112, first paragraph, for the reasons of record set forth in the Office action of 7/3/01, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-23 remain rejected under 35 U.S.C. 112, second paragraph, for the reasons of record set forth in the Office action of 7/3/01, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1632

***Conclusion***

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX numbers are (703) 308-4242 or (703) 305-3014 for any type of communication. In addition, FAX numbers for a computer server system using RightFAX are also available for communications before final rejection, (703) 872-9306, and for communications after final rejection, (703) 872-9307, which will generate a return receipt. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or

Art Unit: 1632

applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 8 AM to 4 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Deborah Clark, can be reached on (703) 305-4051.

Any inquiry concerning administrative, procedural or formal matters relating to this application should be directed to Patent Analyst Patsy Zimmerman whose telephone number is (703) 308-8338. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Scott D. Priebe, Ph.D.  
Primary Examiner  
Technology Center 1600  
Art Unit 1632